

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CATHERINE SHOEMAKER

Appeal 2006-1679
Application 09/853,568
Technology Center 3700

Decided: February 28, 2007

Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and LINDA E. HORNER, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 19 to 26. These are all the claims in the application.

The claimed invention is directed to a label for marking prescription medicine containers. The labels have a picture or non-textual descriptive graphic that conveys information to the user of the prescription medicine.

Claim 22, reproduced below, is further illustrative of the claimed subject matter:

22. A label for marking a prescription medicine container, comprising:

a first side having an adhering surface capable of adhering to said prescription medicine container; and

a second side having only a non-textual, descriptive graphic that conveys the type of prescription medicine within said prescription medical container.

The references of record relied upon by the Examiner as evidence of obviousness are:

Griffiths

US 5,435,600

Jul. 25, 1995

Walgreens, website printout from http://walgreens.com/store/product_sku=396234, AcidFree (last visited October 2, 2000).

Claims 22-26 stand rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure lacking written description support.

Claims 19-26 stand rejected under 35 U.S.C. § 103 as unpatentable over Griffiths in view of Walgreens.

With respect to the rejection under § 112, Appellant groups claims 22-26 together. Therefore, claims 23-26 will stand or fall with claim 22. With respect to the § 103 rejection, Appellant intends that claims 19-26 stand or fall separately.

ISSUES

With respect to the § 112 rejection, Appellant argues that the Specification conveys to one of ordinary skill in the art that Appellant was in possession of the label having only a non-textual descriptive graphic.

With respect to the § 103 rejection, Appellant argues that Griffiths supports only the identification of the prescription medication by textual information. Appellant further argues that the type of printed matter represented by Appellant's graphic icon is the type of printed matter that may well constitute structural limitations upon which patentability can be predicated. Appellant also argues that the Walgreens publication is not prior art, and that Walgreens when combined with Griffiths would not disclose or suggest the indicia being a picture or a graphic, let alone identifying a prescription medicine.

Accordingly, there are two issues presented for this appeal. First, has the Examiner established that claims 22-26 are based on a Specification that lacks written description support for a label second side having only non-textual descriptive graphic material, and secondly, has the Examiner established the prima facie obviousness of claims 19-26?

FINDINGS OF FACT

With respect to the § 112 rejection, Appellant relies on four passages excerpted from Appellant's Specification. These passages are quoted on pages 11 and 12 of the Brief. Appellant further relies on the Figures. The first passage Appellant quotes reads as follows:

One embodiment of the present [invention] helps alleviate these concerns by placing *graphical icons* on the outside of the medicine containers, so that when the patients look at these containers he or she will know why the medication has been prescribed. For instance, a

picture of a knee with an arrow pointing to the knee lets the patient know the medication is for the pain in their knee.

We find nothing in this quoted passage that indicates that only graphical icons are used on the label for marking the prescription medicine container. This passage states little more than the graphical icons are placed on the outside of the medicine containers.

The second passage Appellant relies on states:

[T]he icon would comprise a picture of an elbow with an arrow pointing to the elbow. Again, looking down at the pictures will greatly help those patients to know what it is for, without having to remember long, technical names.

Once again, this passage does not inform us that only non-textual graphic matter is on the label. This passage clearly refers to the icon alone and not to the remainder of the label. Furthermore, the passage mentions the icon using the word “comprise” which in patent nomenclature generally refers to an open-ended description of the subject matter. Since this passage is referring only to the icon, it can not provide evidence that an icon is the only subject matter on the label.

The third quotation Appellant points to as descriptive support for the subject matter of claim 22 states the following:

The deficiencies of the prior art may be overcome through the use of a medicine receptacle labeling system and method that includes the placement of an iconic label upon the rear receptacle exterior. Such *an iconic label would graphically assist* the patient in taking the proper medication by including a descriptive icon to graphically depict either the symptoms and/or desired result for which the medicine contained therein is to be taken.

Here again we find open-ended terminology, *viz.*, while the label system includes the placement of an icon, it does not indicate that only an icon is present on the label.

The last quoted passage from Appellant's Specification states that One embodiment of iconic label 30 includes a printable media 32 upon which *a graphical icon 34* is printed or otherwise represented Graphical icon 34 upon icon label 30 is selected to be indicative of either the medicine contained within receptacle 20 or its intended use. Icon 34 may be selected from a *wide assortment of graphical depictions* that indicate the contents of receptacle 20. . . .

Here again, as with Example 3, we find only open-ended language, with no indication that the label contains only a graphical or iconic depiction. We disagree with Appellant that these quotations make clear that the label is a pictorial or graphic label and does not include any textual subject matter.

Appellant further refers to the Figures in Appellant's application. We find the Figures to be so general that they are useless in providing evidence in favor of Appellant's position. Figures 1 and 2 show primary labels 16 and 26 as entirely blank. Certainly it cannot be said that Appellant contemplates providing the primary label of the prescription medication entirely blank. This indicates to us Appellant has left off all textual material in the drawings in order to simplify the figures. Since Appellant has left all textual material out of the figures, we are unable to credit Figure 3 as conveying only an icon with no textual material thereon. Furthermore, we merely note the Examiner's remarks that the z's in Figure 3 are textual material.

Turning now to our findings with respect to the obviousness rejection on appeal, we note that Griffiths discloses a label for describing prescription medication contained in a prescription medication bottle. The label has both

general printed indicia 21 and handwritten indicia 22 provided on the second side to convey information about the prescription. The first side of the label has an adhesive to adhere it to the medication bottle.

The Walgreens reference appears to be an internet webpage offering for sale an over-the-counter acid-free digestive aid. The bottle depicted therein has a label adhered to the surface which appears to have a graphical depiction thereon. The depiction appears to be the neck, thorax, and upper abdomen of a human with the esophagus and stomach depicted thereon in a stylistic representation. We note that the medication in Acid-Free is designated as being for everyday stomach discomfort. Therefore, we find the label in Walgreens has a non-textural descriptive graphical depiction of the symptoms, the body parts, the ailment, or the desired result for which the medicine contained in the bottle is used.

PRINCIPLES OF LAW

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact. *Regents of Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997), *cert. denied*, 523 U.S. 1089 (1998)(citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991)). To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that “the inventor invented the claimed invention.” *Id.* (citing *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) and *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (“[T]he description must clearly allow persons of ordinary skill in the art to

recognize that [the inventor] invented what is claimed”)). Thus, an applicant complies with the written description requirement “by describing the invention, with all its claimed limitations, not that which makes it obvious,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.” *Id.* (citing *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966). It is important to note that “[t]he invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed.*” *Vas-Cath*, 935 F.2d at 1564, 19 USPQ2d at 1117.

Before discussing the claimed subject matter specifically, as well as the prior art and the examiner’s rejections, we turn to the vexing question of claim limitations directed to printed or written matter. Nonfunctional descriptive material cannot render nonobvious an invention that is otherwise obvious over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)(when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Our reviewing court and its predecessor have frequently cautioned the Patent and Trademark Office (PTO) that all claim limitations must be considered when determining patentability over the prior art. *In re Lowry*, 32 F.3d 1579, 1582-83, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) *quoting In re Gulack* 703 F.2d 1381, 1384, 217 USPQ 401, 403-04 (Fed. Cir. 1983). Furthermore, the Federal Circuit has cautioned against a liberal use of a printed matter rejection. *Id.*, 32 F.3d at 15821-83, 32 USPQ2d at 1034. Nonetheless, we recognize in the instant case the classic printed matter situation in which Appellant is advancing patentability based on the content of the labels of the invention. These printed matter cases “dealt with claims defining as the invention

certain novel arrangements of printed lines or characters, useful and intelligible only to the human mind.” *Id.* quoting *In re Bernhart*, 417 F.2d 1395, 1399, 163 USPQ 611, 615 (CCPA 1969). Accordingly, although we will not disregard any claim limitations and will assess the claimed invention as a whole, we will follow the Federal Circuit’s guidance as in the *Gulack* decision and will “not give any patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate.” *Id.* (Emphasis supplied).

An electronic publication, including an on-line database or Internet publication, is considered to be a “printed publication” within the meaning of 35 U.S.C. § 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates. *See In re Wyer*, 655 F.2d 221, 227, 210 USPQ 790, 795 (CCPA 1981)(“Accordingly, whether information is printed, handwritten, or on microfilm or a magnetic disc or tape, etc., the one who wishes to characterize the information, in whatever form it may be, as a ‘printed publication’ * * * should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents” (citations omitted)). *See also Amazon.com v. Barnesandnoble.com*, 73 F.Supp. 2d 1228, 1233-34, 53 USPQ2d 1115, 1119 (W.D. Wash. 1999)(Pages from a website were relied on by defendants as an anticipatory reference (to no avail), however status of the reference as prior art was not challenged); *In re Epstein*, 32 F.3d 1559, 1556-57, 31 USPQ2d 1817, 1822 (Fed. Cir. 1994)(Database printouts of abstracts which were not themselves prior art publications were

properly relied as providing evidence that the software products referenced therein were “first installed” or “released” more than one year prior to Applicant’s filing date).

Finally, we note that non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. *In re Merck*, 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

ANALYSIS

As noted above in our findings of fact, we did not find any passage from the Specification or any Figure that conveys possession of the subject matter of a label having only a non-textual descriptive graphic icon thereon. Accordingly, it was our finding that the Examiner has established that Appellant does not have written description support for a limitation in claim 22. Claims 23-26 will fall with claim 22.

As noted above, our findings of fact reveal that Griffiths discloses a label for a prescription medicine that is capable of being mounted to the prescription medicine receptacle, in this case a prescription bottle. We have further noted that Walgreens discloses a label having a picture of the stomach, and that picture alone, i.e., by itself, identifies the medicine in the bottle as being stomach medicine, as required by claim 19. In our view it would have been obvious to place a label such as the AcidFree label shown in Walgreens on a prescription bottle such as the bottle shown in Griffiths. We note that the only difference between the Walgreens bottle and the claimed subject matter is that the Walgreens bottle is an over-the-counter medication rather than a prescription medication.

We note the argument in the first full paragraph on page 14 of the Brief. Appellant argues that Griffiths does not disclose the various features recited in the claims on appeal. However, we note that the rejection on appeal is one for obviousness and is based on the collective teachings of the references. Thus, an attack on an individual reference as not disclosing features clearly present in another reference is unavailing.

Furthermore, we are in agreement with the Examiner that the exact printed material found on the label is non-functional descriptive matter that is not functionally related to the substrate as in *Gulack*. Though Appellant argues *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969) in the Brief, Appellant does not state how the graphic icon on the claimed label functions any differently than the labels disclosed in Griffiths and in Walgreens. Appellant's claimed label merely identifies the contents of the bottle to the user. This is the same function as the labels disclosed in Walgreens and Griffiths. It matters not, that the prior art uses letters and numbers and the Appellant uses symbols, if the functioning of the printed matter is the same. The printed matter in this instance merely serves to indicate the contents of the bottle. Since the subject matter of all claims on appeal, i.e., claims 19-26, differs from the Griffiths disclosure only with respect to the printing on the label, all claims are unpatentable over Griffiths under § 103.

Finally, we note Appellant's argument that the Walgreens webpage printout is not prior art. As far as we can determine, Appellant does not give a reason why Walgreens should not be considered prior art. Appellant's conclusory statements in this regard are not credited.

CONCLUSION

The Examiner has established that claim 22 is directed to subject matter that does not have written description support in Appellant's Specification. The rejection of claims 22-26 under 35 U.S.C. § 112, first paragraph, is affirmed.

The Examiner has further established that claims 19-26 are unpatentable under 35 U.S.C. § 103.

ORDER

All rejections on appeal are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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